

Serial #: 09/976,443

In response to Office Action dated March 29, 2005

Page 6 of 8

REMARKS

This is in response to the Office Action mailed on March 29, 2005. Claims 25-41 are pending in the application and were rejected. With this Amendment, claims 25, 32 and 37 are amended. The remaining claims are unchanged in the application.

Claims 25-41 were rejected under 35 U.S.C. 103(a) as being unpatentable over Moran in view of Maggioncalda. Applicant respectfully submits that the amended claims are patentably distinguishable over the prior art of record.

For example, the claims have been amended to make clear a distinction from Moran. Specifically, the automated coaching advice is "directed to the personal financial data, preferences, and financial goals of the user," as set forth in the claims. In contrast, the system in Moran is not intended to be used directly by the user whose personal financial data, financial goals and preferences are being processed or the end user of the automated coaching device. The person who interacts with the system of Moran is a financial advisor who counsels the owner of the financial portfolio.

In response to the assertion in the Office Action that the system of Moran "can be clearly used by the user directly to save the user expenses," the Applicants respectfully disagree. The system in Moran is not set up for individual user use, because it is too complicated and includes many more features that would not be applicable to an end user. Also, it is set up for a trained financial advisor rather than the end user. The system of Moran is also intended to be used by far fewer people than the potential amount of individual users, and there is no suggestion in the prior art on how to modify the system of Moran to provide the system directly to user or to make it applicable to a novice user. Accordingly, Applicants respectfully submits that the claims now are distinguishable from Moran in that the system is to be used directly by the user.

Serial #: 09/976,443

In response to Office Action dated March 29, 2005

Page 7 of 8

The Office Action also states that Moran does not disclose "wherein the proposed product configuration includes recommended securities for the user to purchase." Instead, the Office Action combines Moran with Maggioncalda because according to the Office Action, Maggioncalda discloses "the system being used by the user directly (see Fig. 1) and wherein the proposed product configuration includes recommended securities for the user to purchase (see col. 10, lines 20-30 and Fig. 5A)." Applicant respectfully submits that the amended claims include features that are not shown or suggested in either Moran or Maggioncalda.

For example, the claims have been amended to make clear the distinction between the coaching feature and the system of Maggioncalda. Maggioncalda categorizes a list of available products that have been previously selected for the user, such as funds that are available through an employer's 401K program. Maggioncalda does not pick the securities. In the amended claims, the proposed product configuration includes recommended securities for the user to purchase from a larger set of securities. The present claims do more than just categorize or rank previously selected securities, but select the securities themselves based on the user's inputs and from a larger set of securities. This is a distinction between the coaching feature of the present claims and the categorizing feature of Maggioncalda.

Because the coaching feature is neither shown nor suggested in the Moran or Maggioncalda, it must be missing from any proposed combination of the two references. Therefore, independent claims 25, 32 and 37 are patentably distinguishable from the prior art of record. For at least these reasons, the corresponding dependent claims pending in the application are also patentably distinguishable from the prior art of record.

Further, Applicants respectfully traverse the statement that it would have been obvious to "modify the method of Moran by adapting the teaching of Maggioncalda so as to

Serial #: 09/976,443

In response to Office Action dated March 29, 2005

Page 8 of 8

guide the user into a more elaborate profit making advice." Applicants respectfully submit that there is no suggestion to combine the references. For example, the references are complete within themselves, solve separate problems, and there is no recognition of the problem facing applicant. Also, the prior art does not provide a solution to that facing Applicants.

Accordingly, Applicants respectfully request that the rejection of claims 25-41 be withdrawn.

CONCLUSION

In light of the above remarks, Applicant asserts that all pending claims listed above are allowable and requests allowance of the present application.

In the event a telephone conversation would expedite the allowance of the present application, the undersigned may be reached at 612-607-7340.

If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees including fees for any extension of time, to Deposit Account No. 50-1901 (Docket 60021-376002).

Respectfully submitted,



Rudolph P. Hofmann, Reg. No. 38,187
Customer No. 29838

OPPENHEIMER WOLFF & DONNELLY LLP
Plaza VII, Suite 3300
45 South Seventh Street
Minneapolis, MN 55405
Phone: (612) 607-7340
Fax: (612) 607-7100
E-mail: rhofmann@openheimer.com